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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/658,879      | 09/08/2000  | Toshihiko Oda        | S0255.0004/P004     | 2562             |

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EXAMINER

PRIETO, BEATRIZ

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,879

Applicant(s)

ODA, TOSHIHIKO

Examiner

B. Prieto

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This communication is in response to Amendment filed 12/31/03, claims 1-7, 9-13 and 15-18 remain pending, and claims 2, 8 and 14 have been cancelled. Claims 1, 3-7, 9-13 and 15-18 have been examined.

2. It is noted that whenever there is an amendment to the claims pursuant to paragraph 37 CFR 1.530 (e-d), there MUST also be supplied, on pages separate from the pages containing the changes, the status (i.e., pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, AND an explanation of the support in the disclosure of the patent for the changes to the claims made by the amendment paper (see MPEP 2234). In this case, support for filed amendment is found on specification, page 11, lines 12-17, thereby claimed term "profile of an ideal virtual device" will be given the broadest reasonable interpretation in light of the specification (see MPEP 2111).

***Claim Rejections - 35 USC § 103***

3. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

4. Claims 1, 3-7, 9-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over ROY et. al (Roy) U.S. Patent No. 6,496,859 B2 in view of OWA et. al. (Owa) U.S. Patent No. 6,348,971 B2.

Regarding claim 1, Roy teaches a system/method usable for selecting a device from a number of devices connected to a network, said apparatus comprising:

a device discovery task 10 ("detecting unit"), which finds or determines ("detects") all devices (35) connected to a network (45) (Roy: col 3/lines 27-37);

parsing functions ("extracting unit"), which extracts ("profiles") information (65) relating to functions or capabilities ("categories") of said devices (Roy: parse information from

responses, i.e. extract: col 2/lines 31-38, 52-57, extract information: col 4/lines 3-12, profile data (65): col 3/lines 51-59 and col 5/lines 35-37);

a device discovery task 10 ("table creating unit"), which generated an arrangement or listing ("table") containing located device information relating to the categories of said devices (Roy: table including listing of devices: col 5/lines 55-col 6/line 6);

a device discovery task 10 ("integrated profile creating unit"), which creates a collection ("integrated profile") of information obtained by combining or adding the information ("i.e. profiles") of said devices (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9);

a browser or web enable PC ("user interface creating unit") which creates a user interface enabling available ("necessary") categories to be selected from the categories of the integrated profile created by said integrated profile creating unit (Roy: col 1/lines 15-23 prior art user selectable functions or capabilities ("categories") from the combined listing devices information ("categories of the integrated profile"));

the integrated profile (i.e. collection of information) constitute a profile (called "ideal virtual device), i.e. information having all function or capabilities, i.e. "categories" of said devices (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9); although prior art teach creating a table containing a listing of said devices used by the user for selecting a device from among said devices, prior art does not teach where the table contains a predetermined arrangement ("priority rankings") for the use of said devices, nor selecting a device from among the said devices based selected categories and the table containing the priority rankings;

Owa teaches a system/method related to the selection of the most appropriate device for use by a user (see abstract, col 1/lines 8-12, and col 2/lines 1-6) including,

a user print condition input section (14) from which a user selects information relating to functions or capabilities ("categories") of said devices (col 4/lines 18-33, col 5/lines 1-25, profile relating categories, col 3/lines 51-col 4/line 5, profile, col 4/lines 53-59);

wherein a device (printer) selection means selects a printer which satisfies the selection criteria from among the printers based on the user selected information (category selection) and the printer information ("profiles") relating to functions or capabilities ("categories") of said

devices retained in the printer information retention means and controls the host computer so as to drive the selected printer (col 2/lines 14-25, device selection, col 5/lines 45-63);

priority rankings for use of said devices, wherein an output destination printer selection section 11 ("selecting unit"), wherein a device having the highest final score is selected as an optimum device printer from among the printers using a criterion, such as the printer name order, ascending order of the number of printer operation times, identification number order, or preset priority (i.e. "priority ranking") (col 6/lines 66-col 7/line 11);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising information relating to the functions or capabilities (categories) of multiple devices having multiple categories, to utilize Owa's teachings for enabling a user select an optimum device from among said devices having multiple categories, including selecting a device based on the user selected categories and the priority ranking of said devices, enabling the generation of a table which contains a predetermined arrangement ("priority rankings") for the use of said devices and selecting a device from among the said devices based the user selected categories and the table containing the priority rankings, motivation would be to enhance Roy's system by preventing the user from devoting a lot of time and effort in checking a large number of devices for a desired specification and performance to select a device providing all the selected required functions, as suggest by Owa.

Claim 2 cancelled.

Regarding claim 3, a user interface which displays information relating to the categories comprising the integrated profile for a user's selection ("with respect to a user") on a display screen (Roy: Fig. 7) and enables the user to select necessary categories from the categories displayed on said display screen (Owa: user enters print conditions: col 4/lines 18-33, user specifies categories: col 5/lines 17-25, 30-31 setting desired print conditions on a GUI).

Regarding claim 4, a memory unit which stores the profiles extracted by said extracting unit (Roy: data structure to store device information: col 3/lines 5-59), wherein, when said selecting

unit has used ("consulted") the stored profiles and determined that there is no device comprising all the categories which have been selected via the user interface, said selecting unit selects said device from among said devices which comprises a part of the selected categories (i.e. given the stored profiles (device information), the categories (device function or capabilities) selected by the user and a predetermined priority, if no device comprises all the categories the device satisfying as much desirable conditions as possible is selected: Roy, col 5/lines 18-25).

Regarding claim 5, when a new category has been selected via said user interface after said device has been selected, said selecting unit reselects said device by including the category which has been selected this time by priority in said part of the categories (i.e. selection of categories by priority enable the selection of device that satisfies selected category (or new category) when the device contains that is satisfies all required categories selected by the user according to a specified priority, e.g. priority B, wherein conditions that should preferable (most of or in part of the categories) (Owa: col 5/lines 1-25)

Regarding claim 6, wherein said devices are printers 35 (Roy: abstract, col 3/lines 27-37).

Regarding claim 7, this claim method includes limitation substantially the same as those discussed on claim 1, same rationale of rejection is applicable, limitations further include, providing before the use of said devices ("beforehand") a table for user's selection, said a table containing an integrated profile (i.e. performing the detection, extraction and creation functions discussed on claim 1, for creating an arrangement, list or table of integrated profile containing information obtained by aggregating or adding all the profiles obtained from the devices (detection: Roy, col 3/lines 27-37, extraction: Roy, parse information from responses, i.e. extract: col 2/lines 31-38, 52-57, table creation: Roy, table including listing of devices: col 5/lines 55-col 6/line 6, creates a collection ("integrated profile") of information obtained by combining or adding the information ("profiles") of said devices: Roy, collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9).

Claim 8 cancelled.

Regarding claims 9-12, these claims are substantially the same as claims 3-6, respectively, same rationale of rejection is applicable.

Regarding claim 13, this claim comprises the computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claim 1, same rationale of rejection is applicable to the computer product claim.

Claim 14 cancelled.

Regarding claims 15-18, these claims comprises the apparatus or software implementation, i.e. computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claims 3-6, respectively, same rationale of rejection is applicable to the computer product claims.

#### *Response to arguments*

5. Applicant argues prior art does not teach claim limitation as recited, specifically, where the integrated profile constituting a profile of an ideal virtual device having all the categories of said device, because in the Roy reference the linked list only includes actual devices and not a profile that constitutes an ideal virtual device.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a profile that constitutes an ideal virtual device) are not recited in the rejected claim(s). This is not a suggestion of any sort. The claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, a profile, i.e. information (see disclosure page 10, lines 17-20) is not a device, information does not constitute a device, nor does the specification support where information constitute a device (see disclosure page 11, lines 12-17).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Prosecution of this application is closed by means of this final office action § 1.113, applicant may request continued examination of the application by filing a Request for Continued Examination of under 37 CFR § 1.114 and providing the corresponding fee set forth in § 1.17(e) for the submission of, but not limited to, new arguments, an information disclosure statement, an amendment to the written description, claims, drawings, or new evidence in support of patentability. Or applicant whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences under 35 U.S.C. §134.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this final action should be mailed to:

**Box AF**

Commissioner of Patents and Trademarks  
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or faxed to the Central Fax Office:

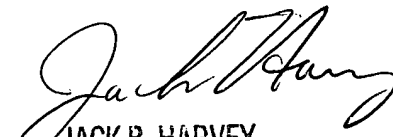
(703) 872-9306, for Official communications and entry

Or Telephone:

(703) 306-5631 for TC 2100 Customer Service Office

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington VA, Sixth Floor (Receptionist).

  
**B. Prieto**  
TC 2100  
Patent Examiner  
March 2, 2004

  
**JACK B. HARVEY**  
SUPERVISORY PATENT EXAMINER